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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK GERSHFELD

Appeal 2008-2879
Application 09/740,065
Technology Center 2400

Decided: January 8, 2009

Before ROBERT E. NAPPI, JOHN A. JEFFERY, and R. EUGENE
VARNDELL, Jr. *Administrative Patent Judges.*

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final
rejection of claim 1.

We affirm the Examiner's rejection of this claim.

INVENTION

The invention is directed towards a method of testing a video system
for degradation of a video signal by simultaneously displaying two images.
The first image is from a signal which has traversed the system (degraded

signal) and the second image is from an identical signal that has not traversed the system. See pages 4 and 5 of Appellant's Specification. Claim 1 is reproduced below:

1. A method of evaluating degradation of a video signal caused by a circuit comprising the steps of:

(a) placing a first video signal in communication with an input of the circuit;

(b) passing the first video signal through the circuit thereby causing the circuit to output a degraded video signal;

(c) providing a means of synchronizing and combining video signals having at least a first and a second input and one output, placing the degraded video signal in communication with the first input of the means of synchronizing and combining video signals;

(d) placing a reference video signal, identical to the first video signal, in communication with the second input of the means of synchronizing and combining video signals;

(e) placing the output of the means of synchronizing and combining video signals in communication with a video display such that full images of the degraded and reference video signals are displayed simultaneously on different portions of the video display; and

(f) visually comparing said full images to assess degradation of the degraded video signal versus the reference video signal.

REFERENCE

Kaneko

US 4,257,066

Mar. 17, 1981

REJECTIONS AT ISSUE

The Examiner has rejected claim 1 under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. The Examiner's rejection is on pages 4 and 5 of the Answer¹.

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Kaneko. The Examiner's rejection is on pages 5 through 7 of the Answer.

ISSUES

Rejection under 35 U.S.C. § 112

Appellant argues on pages 3 through 5 of the Brief² that the Examiner's rejection of claim 1 under 35 U.S.C. § 112 first paragraph is in error. Appellant argues that contrary to the Examiner's findings the term "full image" is supported by the original Specification.

Thus, we are presented with the issue of whether Appellant has shown that the Examiner erred in finding that the originally filed Specification lacks support for the limitation of displaying the full image.

Rejection under 35 U.S.C. § 103

Appellant argues on pages 6 through 10 of the Brief that the Examiner's rejection of claim 1 under 35 U.S.C. § 103 is in error. Appellant argues that Kaneko teaches a system which displays half of one image and

¹ Throughout the opinion, we make reference to the Answer, mailed November 28, 2007, for the respective details thereof.

² Throughout the opinion, we make reference to the Brief, received February 28, 2006 (as corrected via the paper received August 6, 2007) for the respective details thereof.

half of another image at the same time. Br. 8. Appellant, thus, concludes that Kaneko does not teach displaying full images of two video signals simultaneously. Br. 8.

Thus, we are presented with the issue of whether Appellant has shown that the Examiner erred in finding that Kaneko teaches displaying two full images simultaneously as claimed.

PRINCIPLES OF LAW

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). In order to meet the written description requirement, the Appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis in original). Finally, "[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561).

In analyzing the scope of the claim, Office personnel must rely on Appellant's disclosure to properly determine the meaning of the terms used

in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (Emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citations and quotations omitted).

FINDINGS OF FACT

1. Appellant’s disclosure teaches, in Figure 1, a display 40 which includes an image of a triangle and surrounding areas.
2. Appellant’s disclosure teaches, in Figure 2, a display 40 which includes two images side by side. Each image includes a triangle and surrounding area, the ratio of the surrounding area to the size of the triangle in the images depicted in Figure 2 is different than in Figure 1.
3. Kaneko teaches a video system where there are two independently tuneable sources that are simultaneously displayed. Abstract.
4. Kaneko teaches that the scan information is stripped from a first of the signals. The system then operates using the scan information and video information from the first signal for half of the scan interval, and the scan information from the first signal with the video information from the second video signal for the second half of the scan interval. Col. 7, ll. 60-68, col. 8, ll. 5-10.
5. Based upon Fact 4, one skilled in the art would recognize that the display during one scan interval would contain half of the image data from the first signal and half of the image data from the second signal.

6. Kaneko teaches that the images may be vertically arranged (first above second below) or horizontally (first left, second right). Col. 9, ll. 5-10.

ANALYSIS

Rejection under 35 U.S.C. § 112

Appellant has not persuaded us that the Examiner erred in finding that the originally filed Specification lacks support for the limitation of displaying the full image. Appellant argues that:

the originally filed specification and drawings make it clear that “full image” means an image that has not been split, clipped, or otherwise broken in parts. It is also clear from the originally filed specification and drawings that “full image” can be scaled to fit on a certain portion of the screen without being split, clipped or broken in parts.

Br. 4. Appellant argues that this definition is supported by Figures 1 and 2 which depict a full triangle in the display 40 of both figures, and because the Specification does not discuss degradation of the image. Br 4-5. While we are in partial agreement with Appellant’s proffered claim interpretation, Appellant has not persuaded us that the originally filed Specification provides adequate support under 35 U.S.C. § 112.

Claim 1 recites “combining video signals in communication with a video display such that full images of the degraded and reference video signals are displayed simultaneously on different portions of the video display.” Thus, it is clear from the claim that the term “full image” is referring to the image conveyed by the video signal. As identified by the Examiner (Ans. 5), the term is not defined by Appellant’s Specification. Appellant has not shown that the term is defined by the Specification, but

rather proffers a definition and asserts that it is supported by the Specification. Br. 4-5. Within the context of the claim, however, we find that one skilled in the art would understand that the term “full image” would mean that all of the image data in the video signal is displayed. Thus, we find the scope of the term “full image” to be broader than argued by Appellant, but agree with Appellant that the scope of the claim includes that the image is not split or clipped.

However, we disagree with Appellant that the Specification demonstrates that Appellant was in possession of the claimed feature of displaying the full images of both video images side by side. As discussed above, for the Specification to provide support, it must convey with reasonable clarity that the Appellant was in possession of the invention. *Vas-Cath*, 935 F.2d at 1563. *Vas-Cath*, 935 F.2d at 1561 Appellant’s argument that the triangles shown side by side in display 40 of Figure 2 are complete and, thus, the Specification supports that full images are displayed is not persuasive. This argument confuses elements or objects in an image with the image itself. The image displayed on display 40 of Figure 1 includes a triangle and surrounding area. Fact 1. Further, the image displayed in display 40 of Figure 2 includes two images. Each image includes a triangle and surrounding area. Fact 2. Thus, the triangle is an element of the image and not the complete image transmitted by the signal. It is unclear from the Specification if the Figure 1 image includes all of the image data in the video signal. However, even if the display in Figure 1 is the full image, it is clear that the images displayed in Figure 2 are not the full images of the signals as the amount of area of the image to the sides of the triangle is smaller, and the area above/below the triangles is larger (in

relation to the triangle than in Figure 1). Thus, it is clear to one viewing the images displayed on display 40 of Figures 1 and 2 that the side by side images of Figure 2 are not “full images” of the video signals. As Appellant has not persuaded us that the Examiner erred in finding that the originally filed Specification provides support for the limitation of displaying the full image, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 112 first paragraph.

Rejection under 35 U.S.C. § 103

Appellant’s arguments have persuaded us that the Examiner erred in finding that Kaneko teaches displaying two full images simultaneously as claimed. In rejecting claim 1, the Examiner states:

Examiner finds no support for appellant assertion that the viewer in Kaneko only sees the images half of the time. In fact, since Kaneko states the images are simultaneously displayed, it is clear the images are simultaneously at the same time. Examiner asserts that simultaneous display was a term of art, well understood at the time the invention was made, in the field of split screen and PIP TV systems, to mean that the two images are displayed at the same time.

Ans. 10. We do not find that the evidence of record supports the Examiner’s findings. As discussed above within the context of claim 1, the term full image means that all of the image data in the video signal is displayed. We agree with the Examiner that Kaneko teaches two video signals are simultaneously displayed. Fact 3. However, we find that during the first half of the scan interval data from one video signal is displayed, and during the second half of the scan interval data from the second video signal is displayed. Facts 4, 5. Thus, the two images displayed do not contain all of the data in the video signals, and as such we do not find that Kaneko teaches

or suggests, displaying full images side by side as claimed. Further, the Examiner has not provided evidence to support the finding that simultaneous display means that all of each of the images is displayed.³ Accordingly, we will not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103.

SUMMARY

We sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 112 first paragraph and we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103.

ORDER

The decision of the Examiner to reject claim 1 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

³ The Examiner has not provided evidence describing implementation of PIP (Picture In Picture) technology. As such, it is unclear if, when implemented, a portion of either of the pictures is obstructed (thus preventing a full image of the obstructed image).

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AFFIRMED

Eld

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